TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. ~~560~~ 150

HENRY WISE, Jr., WHO SUES FOR THE USE OF HORACE H. DARST AND WARREN J. NACE, PLAINTIFF,

vs.

EDWARD P. ALLIS, DEFENDANT.

CERTIFICATE OF DIVISION OF OPINION BETWEEN THE JUDGES OF THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF WISCONSIN.

FILED DECEMBER 11, 1888.

SUPREME COURT OF THE UNITED STATES.

No. 360.

HENRY WISE, JR., WHO SUES FOR THE USE OF HORACE H. DARST AND WARREN J. NACE, PLAINTIFF,

vs.

EDWARD P. ALLIS, DEFENDANT.

ON CERTIFICATE OF DIVISION OF OPINION BETWEEN THE JUDGES OF THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF WISCONSIN.

INDEX.

	Original.	Print.
Præcipe for summons	2	1
Bond for costs	3	1
Sumons	4	2
Return to summons	4	3
Appearance of defendant	5	3
Declaration	5	3
Plea	11	6
Notice with plea	11	6
Trial	14	7
Certificate of division of opinion	15	8
Clerk's certificate	19	9

1 Circuit Court of the United States of America for the district of Wisconsin.

UNITED STATES OF AMERICA, *District of Wisconsin, ss:*

At a stated term of the circuit court of the United States of America for the district of Wisconsin, began and held according to law at the city of Milwaukee, in said district of Wisconsin on the second Monday (being the fourteenth day) of September, A. D. 1868.

Present and presiding, the Honorable David Davis, associate justice of the Supreme Court of the United States, assigned to this circuit, and the Honorable Andrew G. Miller, district judge, Cassius Fairchild, marshal, Edward Kurtz, clerk.

Among other the following proceedings were had, to wit:

HENRY WISE, Jr., who sues for the use of Horace H. Darst and Warren J. Nace, plaintiff,
vs.
EDWARD P. ALLIS, defendant. } At law.

Be it remembered that heretofore, to wit, on the twentieth day of November, A. D. 1866, came the above-named plantiff by his attorney, Mr. Walker, and filed his præcipe for a summons against the above-named defendant, as follows, to wit:

2 Circuit Court of the United States, district of Wisconsin.

Præcipe for summons.

HENRY WISE, Jr., a citizen of Illinois, who sues for the use of Horace H. Darst and Warren J. Nace, citizens of the State of Ohio,
vs.
EDWARD P. ALLIS, a citizen of the State of Wisconsin.

To the clerk of said court:

You will please issue a summons for the defendant in the above-entitled cause, returnable to next term of said court in an action of trespass in the case, damages eight thousand dollars.

I. P. WALKER, *Att'y for Pl'ffs.*

And also filed bond for costs, as required by the rules of court, as follows, to wit:

3 Know all men by these presents, that we, Henry Wise, jr., and Josiah A. Noonan, the first as principal, second as surety, are held and firmly bound unto Edward P. Allis in the sum of two hund-

red dollars, to be paid to the said Edward P. Allis, or his executors, administrators, or assigns; to which payment well, and truly to be made and done, we do bind ourselves, our heirs, executors, and administrators, jointly and severally, firmly by these presents.

Sealed with our seals, the 20th day of November, A. D. 1866.

Whereas, an action of trespass on the case about to be commenced at the suit of said Henry Wise, jr., for the use of Horace H. Darst and Warren J. Nace, against the said Edward P. Allis; now, therefore, the condition of this obligation is such, that if the plaintiff will pay all costs that may be awarded against him, not exceeding the aforesaid sum, then this obligation to be void, else valid.

HENRY WISE, JR.
[SEAL.] By J. P. WALKER, *His Attorney.*
[SEAL.] J. A. NOONAN.

Witness :

DISTRICT OF WISCONSIN, *ss :*

Josiah A. Noonan being sworn, does say that he is worth the sum of one thousand dollars, exclusive of property exempt from execution, and his debts. J. A. NOONAN.

Subscribed and sworn to before me, the 20th day of November, A. D. 1866. SIMEON KING,
Notary Public Mil. Co.

Endorsed : Approved and filed November 20, 1866.
A. SCOTT SLOAN, *Clerk.*
By JAMES McFARLIN, *Deputy.*

Whereupon a summons issued, as follows :

4 THE UNITED STATES OF AMERICA, *District of Wisconsin, ss :*

The President of the United States of America, to the marshal of the district of Wisconsin, greeting :

You are hereby commanded to summon Edward P. Allis to appear before the circuit court of the United States of America, for the district of Wisconsin, in the seventh circuit, at the United States court-room, in the city of Madison, on the first Monday of January next ensuing, then and there to answer unto Henry Wise, jr., for the use of Horace H. Darst and Warren J. Nace, in a plea of trespass on the case, to his damage eight thousand dollars, which shall then and there be made to appear, and of this writ make due return.

Witness, the Hon. Salmon P. Chase, Chief Justice of the Supreme Court of the United States, at the city of Milwaukee, in the said district, this 20th day of November, in the year of our Lord one thousand eight hundred and sixty-six, and of the independence of the United States, the ninety-first.

[SEAL.] A. SCOTT SLOAN, *Clerk.*
By JAMES McFARLIN, *Deputy.*

I. P. WALKER, *Attorney.*

[50 ct. int. rev. stamp, cancelled.]

And aftewards, and on or before the return day of said writ, came the said marshal, and returned the same, with his return endorsed thereon, as follows:

Return.

"Served on the within-named Edward P. Allis, by showing him this summons and delivering to him a copy thereof, this 21st day of November, 1866.

"CASSIUS FAIRCHILD, *Marshal.*
"By WM. S. JACKSON, *Deputy.*"

Fees, $2 26.

And afterwards, to wit, on the 24th day of November, A. D. 1866, came the defendant by his attorney, Mr. Carpenter, and filed his appearance, as follows:

Circuit court of the United States.

Appearance.

HENRY WISE, jr., for the use of Horace H. Darst and Warren J. Nace,
against
EDWARD P. ALLIS.

Please take notice that I have been retained for the defendant in the above-entitled cause, and appear for him therein, and demand that copy of the complaint be served on me at my office at 397 East Water street, Milwaukee, room No. 5.

Yours, &c.

MATT. H. CARPENTER.
Attorney for Defendant.

To I. P. WALKER, Esq.,
Attorney for Plaintiff.

DECEMBER 22, 1866.

This day came the plaintiff by his attorney, and filed his declaration, as follows:

United States circuit court, district of Wisconsin.

Declaration.

HENRY WISE, jr., who sues for the use of Horace H. Darst and Warren J. Nace,
vs.
EDWARD P. ALLIS.
Of the Jaunary term, 1866.

Henry Wise, jr., a citizen of the State of Illinois, who sues for the use and benefit of Horace H. Darst and Warren J. Nace, citizens of the State of Ohio, complains of Edward P. Allis, a citizen
6 of the State of Wisconsin, of a plea of trespass on the case.

For that whereas, one John Fairclough, a citizen of the State of Kentucky, before and at the time of making and issuing the letters patent, and of the committing of the grievances by the said defendant as hereinafter mentioned, was the true and first inventor of a certain improvement in balancing millstones; and thereupon, heretofore, to wit, on the second day of August, A. D. 1859 in Washington city, in the District of Columbia, to wit, in the State of Wisconsin aforesaid, the United States did make and issue their letters patent, bearing date at Washington, the day and year aforesaid, under the seal of the United States Patent Office; and which said letters patent the said plaintiff now brings here into court;) whereby, by and through one Jacob Thompson, then the Secretary of the Interior of the United States, after reciting that the said John Fairclough, of Louisville, Kentucky, had alleged that he had invented a new and useful improvement in balancing millstones, (for which letters patent had been issued to him, dated December 21st, 1858, and which said last-mentioned letters having been surrendered by him, had been cancelled, and new letters ordered to issue to him on an amended specification,) which improvement, he stated,
7 had not been known or used before his application; and had made oath that he was a citizen of the United States, and that he verily believed he was the original and first inventor or discoverer of the said improvement, and that the same had not, to the best of his knowledge and belief, been previously known or used, and that he, the said Fairclough, had paid into the treasury of the United States the sum of fifteen dollars, and had presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent might be granted for that purpose; the United States did grant, according to law, to the said John Fairclough, his heirs, administrators, and assigns, for the term of fourteen years from the 21st day of December, 1858, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement; a description whereof was and is given in the words of the said John Fairclough in the schedule which was and is annexed to said letters patent, and which schedule, also, the said plaintiff now brings here into court. And whereas the said plaintiff further says that the said John Fairclough afterwards, and before the committing of the several grievances by the said defendant hereinafter mentioned, to wit, on the 18th day of October, 1859, at
8 and in the State of Wisconsin aforesaid, by a certain deed poll, then and there made and delivered by the said John Fairclough to one Lewis Morris, a citizen of the said State of Illinois, (and which deed poll, sealed with the seal of the said John Fairclough, the said plaintiff now brings here into court, the date whereof is the day and year last aforesaid,) he, the said Fairclough, patentee as aforesaid, for the consideration in said deed poll mentioned, did assign, sell, and set over unto the said Lewis Morris and his assigns all the right, title, and interest, which he, the said John Fairclough, had in and to said invention as secured to him by said letters patent, for, to,

and in all of the States and Territories of the United States, saving and excepting only the States of Missouri, Tennessee, and Kentucky.

And whereas the said plaintiff further says that the said Lewis Morris, afterwards, and before the committing of the several grievances by said defendant hereinafter mentioned, to wit, on the first day of June, A. D. 1863, at and in the State of Wisconsin aforesaid, by a certain other deed poll then and there made and delivered by the said Lewis Morris, (and which said last deed poll, sealed with the seal of the said Lewis Morris, the said plaintiff now brings
9 here into court, the date whereof is the day and year last aforesaid,) he, the said Lewis Morris, assignee as aforesaid, for the consideration in said last deed poll mentioned, did assign, sell, and set over unto the said plaintiff and his assigns all the right, title, and interest which he, the said Morris, had in said invention, (as secured to said Fairclough as aforesaid, and assigned to him as aforesaid, by said Fairclough,) for, to, and in all of the States and Territories of the United States, saving and excepting the said States of Missouri, Tennessee, and Kentucky. Whereby the said plaintiff avers that he became, before the committing of the grievances hereinafter mentioned, and that he ever since has been and still is, the exclusive and only legal owner and holder of all the right, title, and interest in and to said invention and improvement as secured by said letters patent, and assigned by said patentee through the said Morris to said plaintiff, for, to, and in the State of Wisconsin, and entitled to the exclusive privilege of making, constructing, using, and vending to others to be used, the said improvement, within the State of Wisconsin.

Yet, the said defendant, well knowing the premises, after the making, issuing, and delivery of the said letters patent, and after the mak-
10 ing and delivery as aforesaid of said deeds, poll, and assignments, and within the said term of years in the said letters patent mentioned, to wit, on the second day of June, A. D. 1863, and on divers other days and times between that day and the day of the commencement of this suit, and within the State of Wisconsin aforesaid, unlawfully and unjustly, without the leave or license, and against the will of the said plaintiff, did make and sell, and has made and sold divers, to wit, two hundred sets of balances, in imitation of the said invention and improvement of the said John Fairclough aforesaid, in breach of the said letters patent, and against the right and privilege thereby granted to the said Fairclough, and derived from him as aforesaid through the said Morris, by and to said plaintiff, to wit, in Wisconsin aforesaid; whereby the said plaintiff alleges that he has been and is injured and damnified to the amount of eight thousand dollars, and, therefore, he brings his suit, &c.

I. P. WALKER,
Attorney for Pl'ff.

JANUARY 4, 1867.

This day came the defendant, by his attorney, and filed his plea and notice, as follows:

11 Circuit court of the United States for the district of Wisconsin.

Plea.

HENRY WISE, to the use, &c.,
v.
EDWARD P. ALLIS.

Here in court comes the said Edward P. Allis, defendant, by Matt. H. Carpenter, his attorney, and defends the wrong and injury, when, &c., and says that he is not guilty of the said supposed grievances above laid to his charge, or any or either of them, or any part thereof, in manner and form as the said plaintiff hath above thereof complained against him, and of this he, the said defendant, puts himself upon the country, &c.

MATT. H. CARPENTER, *Att'y for Def't.*

Notice.

To Isaac P. Walker, esq., attorney for the plaintiff:

SIR: Please take notice that on the trial of the issue in this action, the defendant will prove, and rely and insist upon, as defence to this action, the following matters of fact, that is to say:

1. That the said defendant has not made nor sold any sets of balances in imitation of the said pretended invention of said John Fairclough, mentioned in the said plaintiff's declaration.

12 2. That the said pretended letters patent issued to the said John Fairclough were, when issued, ever since have been, and now are, wholly null and void, for the reason, among others, that the said pretended invention of the said John Fairclough, covered by said pretended letters patent, was well known, and was in common and general use long before the said John Fairclough pretended to have invented the same, and years before the said John Fairclough applied for letters patent therefor, to wit: The same was in common and general use in Utica, Rochester, Buffalo, Albany, New York city, and Brooklyn, in the State of New York, and in divers other places in the United States unknown to this defendant. That the said defendant will prove these facts by the following, among other witnesses, viz:

John I. Noy, of Buffalo, New York.
Alexander C. Hart, Utica, N. York.
Edmund Munson, Utica, N. York.
William F. Noye, Chicago, Illinois.
Samuel Taggart, Indianapolis, Indiana.
Francis Taggart, Brooklyn, N. York.

3. That the kind of balances which this defendant has manufactured and sold, and all that he ever did manufacture or sell,

13 had long been well known, and been in common and general use in Buffalo, Rochester, Utica, and Brooklyn, in the State of New York, long before the said Fairclough pretended to have in-

vented the same, and before he applied for letters patent therefor; and that the said Fairclough was not the original or first inventor thereof, but, that on the contrary thereof, the same was originally and first invented by the said Francis Taggart above named, and that said invention was in common and general use by the witnesses above named in the places above named long before the said Fairclough pretended to have invented the same or applied for said letters patent therefor, and that the first patent issued to said Fairclough did not include or cover the same, but only an improvement thereon; that the said second letters patent mentioned in said declaration, if it did embrace and cover the kind of balance manufactured and sold by this defendant, were void, for the reason that the said balances manufactured and sold by said defendant were not invented by said Fairclough, but were well known and in common and general use by the persons above named as witnesses in the places above named, long before said Fairclough applied for or received letters patent therefor.

Yours, &c.,

MATT. H. CARPENTER,
Attorney for Def't.

14 SEPTEMBER 16, 1867.

This day came the defendant, by his counsel, and on his motion and affidavit filed, it is ordered by the court that this cause be continued, on the payment of the costs of this term by the defendant, and that the defendant have leave to amend his notice within thirty days.

And now, at this same term, to wit, September term, A. D. 1868, and on the fourth day thereof, to wit, on the 17th day of September, A. D. 1868, the following proceedings were had, to wit:

Trial.

HENRY WISE, Jr., who sues for the use of Horace H. Darst & Warren J. Nace, *vs.* EDWARD P. ALLIS. } At law.

This day came the parties, by their counsel, and the issue herein came on to be tried, whereupon a jury was called to try the same, who came, to wit: Richard B. Winsor, James A. Bryden, Philo Belden, Ephraim C. Goff, William T. Bonniwell, Nathaniel S. Donaldson, Benjamin R. Hinkley, Alanson Filer, Homer Glass, Charles W. Prescott, Sidney L. Rood, and Nathan G. Storrs, twelve free, honest, and lawful men of the district, who were severally sworn and empanneled, and the trial not being concluded, the same was adjourned until to-morrow morning.

15 And afterwards, to wit, on the fifth day of said term, to wit, on the 18th day of September, A. D. 1868, the following proceedings were had, to wit:

Trial resumed.

HENRY WISE, Jr., who sues for the use of Horace H. Darst & Warren J. Nace, *vs.* EDWARD P. ALLIS. } At law.

This day came the parties by their counsel, and the trial of the issue herein was resumed, when, on a certificate of division of opinion between the judges, as herein filed, signed by them, the jury was discharged, and which certificate is as follows, to wit:

Certificate of division of opinion.

UNITED STATES OF AMERICA, *District of Wisconsin, ss:*

At a stated term of the circuit court of the United States for the district of Wisconsin, begun and held according to law at the city of Milwaukee, in the district of Wisconsin, on the second Monday (being the 14th day) of September, A. D. 1868; present and presiding the Honorable David Davis, associate justice of the Supreme Court of the United States, assigned to said circuit, and the Honorable Andrew G. Miller, judge of the district court of the United States for the district of Wisconsin; and on the 5th day of said term, to wit, on the 18th day of September, A. D. 1868, the following proceedings were had, to wit:

16 HENRY WISE, Jr., for the use of H. H. Darst and Warren J. Nace, *vs.* EDWARD P. ALLIS. } At law.

This day came the parties by their counsel, Mr. Walker for the plaintiff and Mr. Carpenter for the defendant, and the court resumed the trial of the issues joined in said cause before the jury empannelled and sworn therein, when the plaintiff, in support of said issues on his part, having introduced and read in evidence the letters patent mentioned in his declaration, and of which profert is therein made, and having given evidence tending to show and prove the utility of the invention mentioned in, and the sufficiency of the schedule or specification annexed to, and forming a part of said letters patent, and the infringement of the said letters patent and invention by the defendant as alleged and charged in the plaintiff's declaration; and the assignment of said letters to the plaintiff, (and the due recording of the said assignment,) as alleged in his said declaration, and also the damages which the plaintiff had sustained by reason of such infringement, did then and there rest his case.

17 Whereupon the defendant, in support of said issues on his part, did offer to give evidence by a witness on the stand, interrogated to that point, tending to prove the facts stated and mentioned in his notice, filed in this cause with his plea of the general issue; to the giving of which evidence, the plaintiff, by his counsel, did then and

there object, for the reason and on the ground that said notice of the defendant was too vague and indefinite as to the places where it is alleged the invention or millstone balance specified in said letters patent had been in use prior to the invention thereof by John Fairclough, the patentee, and plaintiff's assignor; and the opinion of the judges of said court being opposed and divided, it is thereupon ordered, on motion of plaintiff's counsel, that the following questions of law, on which said division and opposition of opinion occurred, be, and the same are hereby, certified to the next term of the Supreme Court of the United States, for its decision, to wit:

1. Is the defendant entitled, under his said notice, to give evidence of the use of said invention or millstone balance by any person or persons prior to the alleged invention thereof by John Fairclough, the patentee thereof, and assignor of the plaintiff?

18 2. Should evidence of such prior use of said invention or millstone balance be excluded on the ground that the notice aforesaid is defective and insufficient for the purpose of such evidence?

Done in open court, at the city of Milwaukee, in said district, this 18th day of September, in the year of our Lord one thousand eight hundred and sixty-eight.

D. DAVIS.
A. G. MILLER.

19 UNITED STATES OF AMERICA, *District of Wisconsin, ss:*

I, Edward Kurtz, clerk of the circuit court of the United States of America, for the district of Wisconsin, do hereby certify that I have compared the writings annexed to this certificate, and they are true copies of their respective originals, and are correct transcripts therefrom now on file and remaining of record in my office, being a full and complete exemplification of the record and proceedings to this date in the suit of Henry Wise, jr, for use of Horace H. Darst *et al*, *vs.* Edward P. Allis.

In testimony whereof, I have hereunto set my hand, and duly affixed the seal of the said court, at the city of Milwaukee, in said district of Wisconsin, this eighth day of October, in the year of our Lord one thousand eight hundred and sixty-eight, and of the independence of the said United States the ninety-third.

[SEAL.] EDWARD KURTZ, *Clerk.*

SUPREME COURT, UNITED STATES.

HENRY WISE, JR., WHO SUES FOR THE USE OF HORACE H. DARST, AND WARREN J. NACE, *Plaintiff*,

vs.

EDWARD P. ALLIS, *Defendant*.

ARGUMENT FOR PLAINTIFF.

SUPREME COURT, UNITED STATES.

HENRY WISE, JR., WHO SUES FOR THE USE OF HORACE H. DARST, AND WARREN J. NACE, *Plaintiff*,

vs.

EDWARD P. ALLIS, *Defendant.*

ARGUMENT FOR PLAINTIFF.

The only question specially urged by plaintiff for the decision of this Court, under the division of opinion certified, is the following :—

Was it sufficient for defendant to name in his notice of special matter, *large cities*, merely, as the places where the mill-stone balance had previously been "*used ;*" or was it necessary to name or *designate the mills*, as well ?

For the plaintiff, it is insisted and urged here, as it was in the Court below, that the notice of defendant is *too vague, indefinite and uncertain*, to entitle him to give evidence of the alleged prior use of the invention, while it names or designates *cities*, merely, and not *the mills* "where" the supposed prior use was made.

I.

In order to appreciate the questions certified, and to properly understand and construe the law of the subject they embrace ; it becomes necessary to consider and keep in view the several Acts of Congress thereon, *in pari materia*, as well as the adjudications under those Acts.

The 6th section of the Act, 21st February, 1793, enumerates certain special defences which, if notice in writing thereof has been given

thirty days before trial, may be offered and given in evidence under the general issue. Among these is the lack of novelty: that is—"that "the thing secured by patent was not originally discovered by the "patentee, but had been in use, &c., anterior to the supposed dis- "covery of the patentee."

In the provision for notice, there is no requirement that the notice shall specify *any place, whatever*, where the invention had previously been used. Notwithstanding this, however, the profession seems to have deemed it proper and fair, if not necessary, in practice or pleading, to name the *particular mills*, where mill-machinery was in controversy. This was done in 1816, in—

Evans vs. Kremer, Pet. C. C. R., 215; and in 1818, in—
Evans vs. Eaton, 3 Wheat., 454.

The Circuit Court in the first, and the Supreme Court in the second of these cases, held the specification of *place*, that is, *the mills*, to be unnecessary; on the ground alleged by the Courts, *that the Act of* '93 *did not require it.*

II.

These rulings, with the consequences, pointed out what was afterwards deemed by Congress a defect in the law. By the year, 1836, experience and practice had shown that, without a specification of the *place* of alleged prior use, patentees were continually surprised by testimony vamped at the trial, which it was impossible to anticipate or prepare to meet. Therefore, in that year, Congress amended the law in this respect, by providing in the 15th section of the Act, (July 4th,) as follows:—

"And whenever the defendant relies in his defence on the fact of a "previous invention, knowledge, or use of the thing patented, he shall "state in his notice of special matter, the names and places of resi- "dence of those whom he intends to prove to have posessed a prior "knowledge of the thing, *and where the same had been used.*"

Mr. Curtis says: "This provision was added in consequence of "the construction given to the former Act, (in *Evans vs. Eaton, supra,*) "to the effect that notice of the *places* was not necessary to be given."

Curtis on Patents, sec. 272.

He is sustained in his assertion by the language of the Court, in—*The Phil. & Trent R. R. Co. vs. Stimpson*, 14 Pet., 448.

In that case, after quoting the provision of the act of '36, the Court says:

"The object of this *most salutory provision is to prevent patentees* "*being surprised at the trial* of the cause, by evidence of a nature "which they could not be presumed to know, or be prepared to meet; "and thereby to subject them either to most expensive delays, or to a "loss of their cause."

From this it appears that the amendment was designed as an important *remedial* provision, to *prevent surprise* upon patentees or plaintiffs in patent causes; and grew out of a conceded, practical, substantial defect in the previous law.

We all know that in construeing a remedial law, three things are to be considered: The *old law;* the *mischief* for which it did not provide; and the *remedy* supplied by the new law. And that the new law should be so construed or administered, as to *suppress* the mischief, and *advance* the remedy.

What, then, was the old law? It was—that, to defend in a patent cause for lack of novelty, notice *need not be given of the place where the thing had been used* prior to the alleged invention thereof.

The mischief not provided against was—that plaintiffs in patent causes were *liable to surprise* from testimony sprung at the trial, which they could not be presumed to know, or be prepared to meet; and from which resulted either expensive delays, or a loss of their causes.

The remedy provided or *designed* was—a suppression of this cause of surprise, by requiring thirty days' notice to be given, not only of the names and places of residence of the witnesses by whom the defence is to be proved; but "*where*," the patented thing had been "*used*," prior to the alleged invention.

This court will of course desire to promote the laudable design of Congress; and the question is, how far it must go in construction in order to do so. One thing would seem certain: that to meet the legislative design, the Court must go at least so far as to suppress the reprehended *cause* of surprise, by requiring fair notice to be given. To do this, it must surely require the notice to show more under the new law than was required under the old; and just so much more as will apprise the plaintiff "*where*" it is designed to prove his invention

to have been previously "*used:*" to the end that he may prepare to meet the proof, if he can, by contradiction or impeachment.

Now, under the old law, no notice was required, at all, of the place where it was claimed the invented thing had been used. Herein lay the source of deprecated surprise. Will you mend the matter any, or lessen the source of surprise, by holding a notice sufficient which is as bad as none at all, in leaving the *place* so indefinite as to require the plaintiff to search, within thirty days, among millions of people, and thousands of *places* or *mills*, in order to learn the facts, or prepare to repel the falsehoods?

But it is claimed for defendant in this case that the notice does specify place: that Utica, Rochester, Buffalo, Albany, New York City, or Brooklyn, *is a place*. So is England, India, France, Spain, or Wisconsin *a place*. To refer the plaintiff to New York City, with her population of thirteen hundred thousand, and her mills, numbering nine hundred and sixteen, as the place where prior use was made of his invention, is the very mock of mockery. Reference to the whole State of Wisconsin, Iowa, Minnesota, or Kansas, had been to a less number of people or mills; and to a place where search could have been made with far less of danger. Under this notice, after plaintiff had travelled from Wisconsin to New York City; had gone the rounds of nine hundred and fifteen of her mills, and returned after incurring onerous expenses, and finding nothing like his invention, and all this within thirty days; he might still be defeated on the trial, by having the fact sprung upon him in evidence, that it was the very nine hundred and *sixteenth* mill in which his cherished invention had been used. Then why not have told him so at first, *in the notice?* He could then have gone to that mill at once. If he had found the notice true, he could have abandoned an unjust suit. If false, could have prepared to repel a pirate's unjust defence. Yet, New York is but one of six large cities named in the notice, to be searched by the plaintiff within thirty days, and a thousand miles away.

This notice is far more indefinite as to place, than it was the practice to make such notices under the act of '93. The practice was, as we have seen, to state the particular *mill* or *mills*. This practice was known to Congress when it passed the remedial act of '36; and it may be fairly presumed that, by amending the old law in this regard, Congress intended to approve the practice. This presumption becomes almost conclusive, when we take into account the language of Chief Justice Marshall in delivering the Court's opinion in ***Evans vs. Eaton***,

which warned Congress of the defect in the law. In that case, when urging that under the act of '93, the defendant had the option to notice the defence, or to plead it, specially; and when arguing that the notice need be no more specific than a special plea as to place of prior use; the Chief Justice says:

"If, then, the defendant may give in evidence on a special plea the "prior *use* of the machine at *places* not specified in his plea, it would "seem to follow that he may give in evidence its *use* at *places* not "specified in his notice. It is not believed that a plea would be "defective which did not state *the mills* in which the machinery, "alleged to be previously *used*, was *placed*."

It is manifest the Chief Justice here employed the word "*places*," as synonymous in that case with the word "*mills*." Indeed, he tells us so, by at last employing the latter instead of the former word, in the same sense. Besides, in the notice he was considering, the *places* named *were mills*. He was therefore speaking of "places" *as mills*; and holding that to state the *mills* was not necessary.

The purport of his language and ruling, then, is this: "That under the act of '93, it is not necessary, either in a plea or notice, to state the *mills* in which the machinery, alleged to be previously *used*, was *placed*."

This language was likewise before Congress when it passed the remedial act of '36; it was this very language, or the mischief under it, which startled Congress as to the state of the law; and it was to *reverse the doctrine* of the language, by *reversing the law*, that Congress moved in the matter, and passed the *remedy*. Then we reach this state of case: The Chief Justice and the old law had declared the defendant need not state in his notice or plea the "*mills*" where the machinery was previously "*placed*" and "*used*." Congress becoming alarmed by this, or by the mischief ensuing, resolved to *reverse* it, and suppress the mischief. Then could Congress have meant anything less than to *declare the reversal* and say, that in future, the notice *must* specify, in cases of alleged prior use of mill machinery, the *mills where* it was previously "*placed*" and "*used?*"

And further: With the old practice in view, of which it approved; with the old ruling before it, which it sought to condemn; and while intending to *reverse the law*, and with it the consequent *ruling;* can it

be supposed Congress at the same time intended the Courts should adhere to the *old* ruling? or should stop short of a construction that would *work* the reversal, and a complete suppression of the mischief lurking in the law, and hence in the ruling, itself? Such a supposition would be one in which courts will never indulge: *that the legislature has acted without purpose or object*. Certainly nothing could be more purposeless than the enactment of a law for a definite end, which was not meant to be enforced, complied with, or carried out to that end.

III.

The words of the Act of '36 are—"*shall* state, in his notice of "special matter, &c.,—*where* the same had been *used*."

The word "*where*," here signifies,—"at or in which place or places." In employing the term, "where," Congress evidently intended, in the case of alleged prior use of mill machinery, *the very mill or mills* "*where*" it had been "*used*;" for it was this very thing, "*the mills*," which the Supreme Court had held it unnecessary to specify or *state*. It was the adjudged non-necessity of specifying the *mills*, with which Congress was dissatisfied, and for which it meant to provide a remedy and reversal.

The Act, then, requires the defendant to state in his notice "where" the alleged invention had been "*used*;" meaning by the term, "*where*," the *mill or mills where*, or in which, it was "*used*."

Now, on general principles of interpretation, can it be said, in the sense of the Act, that a mill-stone balance is ever "*used*" *in, or with relation to a city?* It may be located in one; but the place "where" it is "*used*," must be *a mill*. A bridge, a sewer or a pavement, may be used in and with relation to a city: they usually are so used; but not mill-stone balances. *Their* place and relation of *use*, are a *mill*, *not* a city. The words of the Act are—"*where used;*" not where *located*.

It is evident, therefore, that the word, "where," is to be interpreted in favor of fairness and justice, in view of its relative subject-matter in each individual case. If the subject-matter of controversy in a given case, were the prior use of a patented bridge, pavement, sewer, street railroad-car, or rail; it might well be held that notice of its prior use in the *largest* city, was sufficiently definite as to the "*place*"

or the "*where*" of its prior use. On the other hand, if the subject of controversy were the previous use of a sewing-machine needle, a button, shirt-stud, or gun-lock; such a ruling would be simply absurd, if it were not also hurtful and mischievous.

IV.

It would hence appear to have been the intention of Congress, to require the notice to designate the place or "*where*" of alleged prior use, fairly, and by some definite, circumscribed locality, *appropriate to the use* of the subject or thing in controversy; and *in such a manner* as to avoid or prevent the surprises or mischief against which it sought to provide.

Nor is there anything burdensome to defendant in this requirement. If he knew the cities, he would know as well the *mills;* or if not, he would not know enough to fairly set up the defence at all. If he knew the mills, he should in fairness have stated them. If he did not know them, his vaunted defence becomes at best but a simple surmise; and the cities he names, but fishing-ground for testimony.

To be just and fair, and to meet the design of Congress, defendant should have given plaintiff the benefit of all information, as to the place of prior use, which he possessed himself; or which was possessed by the witnesses he names. Surely, if these witnesses had ever seen the balance "used" prior to the alleged invention, they could tell the very mills "where" they had seen it "used." If they could not do this—if they could only say they had seen it *located* in Buffalo, New York, or other city, their testimony would fail to sustain the defence. The necessity of *proving* the mills where used, would seem to indicate the necessity of *stating* them in the notice; for the spirit of the act evidently requires a statement in the notice, of what is intended to be proved in the defence, so far as relates to the place or "where" of the alleged prior use of the invention.

If this reasoning be correct, the notice under consideration does not even *state* a defence.

I. P. WALKER,

Plaintiff's Counsel.

SUPREME COURT OF THE UNITED STATES.

HENRY WISE, JR., WHO SUES FOR THE USE OF HORACE H. DARST, AND WARREN J. NACE, *Plaintiff*,

vs.

EDWARD P. ALLIS, *Defendant*.

PLAINTIFF'S ABSTRACT AND POINTS.

SUPREME COURT OF THE UNITED STATES.

HENRY WISE, JR., WHO SUES FOR THE USE OF HORACE H. DARST, AND WARREN J. NACE, *Plaintiffs*,

vs.

EDWARD P. ALLIS, *Defendant.*

ABSTRACT OF RECORD.

This case comes up on certified division of opinion between the judges of the United States Circuit Court for the District of Wisconsin.

The plaintiff sued the defendant in the court below for infringing a patent for improvement in the means for balancing mill-stones, which patent was granted and issued to one John Fairclough on the second day of August, 1859, and was by him assigned to plaintiff for the State of Wisconsin. The declaration is in the usual form.

The defendant pleads the general issue; and with the plea gives the following notice:

To Isaac P. Walker, Esq., Attorney for the Plaintiff:

SIR—Please take notice that on the trial of the issue in this action, the defendant will prove, and rely and insist upon, as a defence to this action, the following matters of fact, that is to say:

1. That the said defendant has not made nor sold any sets of balances in imitation of the said pretended invention of said John Fairclough, mentioned in the plaintiff's said declaration.

2. That the said pretended letters patent issued to said John Fairclough were, when issued, ever since have been, and now are, wholly null and void, for the reason, among others, that the said pretended

invention of the said John Fairclough, covered by said pretended letters patent, was well known, and was in common and general use long before the said John Fairclough pretended to have invented the same, and years before the said John Fairclough applied for letters patent therefor, to wit: The same was in common and general use in Utica, Rochester, Buffalo, Albany, New York City, and Brooklyn, in the State of New York, and in divers other places in the United States unknown to this defendant. That the said defendant will prove these facts by the following, among other witnesses, viz:

John I. Noy, of Buffalo, New York.
Alexander C. Hart, Utica, New York.
Edward Munson, Utica, New York.
William F. Noye, Chicago, Illinois.
Samuel Taggart, Indianapolis, Indiana.
Francis Taggart, Brooklyn, New York.

3. That the kind of balances which this defendant has manufactured and sold, and all that he ever did manufacture or sell, had long been well known, and been in common and general use in Buffalo, Rochester, Utica and Brooklyn, in the State of New York, long before the said Fairclough pretended to have invented the same, and before he applied for letters patent therefor; and that the said Fairclough was not the original or first inventor thereof, but that on the contrary thereof, the same was originally and first invented by the said Francis Taggart above named, and that said invention was in common and general use by the witnesses above named in the places above named long before the said Fairclough pretended to have invented the same or applied for letters patent therefor, and that the first patent issued to said Fairclough did not include or cover the same, but only an improvement thereon; that the said second letters patent mentioned in said declaration, if it did embrace and cover the kind of balances manufactured and sold by the defendant, were void, for the reason that the said balances manufactured and sold by this defendant were not invented by said Fairclough, but were well known and in common and general use by the persons above named as witnesses in the places above

named, long before said Fairclough applied for or received letters patent therefor.

Yours, &c.,

MATT. H. CARPENTER,
Attorney for Defendant.

At the trial of the case on the 18th day of September, 1868, the plaintiff, having finished the proofs on his part, rested his case. Whereupon the defendant, in support of the issue on his part, offered to give evidence tending to prove the facts stated in his notice; but to the giving of which evidence, the plaintiff by his counsel objected, on the ground—

"*That said notice of the defendant was too vague and indefinite as to the places where it is alleged the invention or mill-stone balance, specified in said letters patent, had been in use prior to the invention thereof* by John Fairclough, the patentee and plaintiff's assignor."

And the opinion of the judges of said court being opposed and divided, it was thereupon ordered, on motion of the plaintiff's counsel, that the following questions of law, on which said division and opposition of opinion occurred, be certified to the next term of the Supreme Court for its decision, to wit:

"1. Is the defendant entitled, under his said notice, to give evidence "of the use of said invention or mill-stone balance by any person or "persons prior to the alleged invention thereof by John Fairclough, "the patentee thereof, and assignor of the plaintiff?

"2. Should evidence of such prior use of said invention or mill- "stone balance be excluded on the ground that the notice aforesaid is "defective, and insufficient for the purpose of such evidence?"

D. DAVIS,
A. G. MILLER.

POINTS AND AUTHORITIES FOR PLAINTIFF.

The only question urged by plaintiff for the decision of this Court, under the division of opinion certified by the Court below, is the following:

Was it *sufficient* for the defendant to name in his notice of special matter, *large cities*, merely, as the *place where* the mill-stone balance had previously been "*used*;" or was it *necessary* to name and designate *the mills*, as well.

I.

The 6th section of the Act, 21st February, 1793, enumerates certain special defences which may be given in evidence under the general issue, if notice in writing has been given thereof, thirty days before trial. Among these special defences is lack of novelty: that is— "that the thing secured by patent was not originally discovered by "the patentee; but had been in use, &c., anterior to the supposed "discovery by the patentee."

In the provision for notice, there is no requirement that the notice shall state or specify any *place*, whatever, *where* the invention had previously been "*used*." Notwithstanding this, the profession seems to have deemed it proper and fair, if not necessary, in practice or pleading under the Act, to name the *particular mills*, where mill-machinery was in controversy. This was done in 1816, in—

Evans vs. Kremer, Pet. C. C. R., 215; and in 1818, in
Evans vs. Eaton, 3 Wheat., 454.

However, the Circuit Court in the first, and the Supreme Court in the second of these cases, held the specification of the *mills*, to be unnecessary; on the ground that the Act of '93 *did not require it*.

II.

These rulings, with the results, brought to light an important defect in the Act of '93. By the year, 1836, experience and practice under the old law and its construction, had shown that without a statement of the place of prior use, patentees had been continually surprised at trials, by testimony which it was impossible to anticipate or prepare to meet. Therefore, in that year, Congress amended the old law in this respect, by providing in the 15th section of the Act, July 4th, that the defendant should state in his notice, "*where the patented thing had been used.*"

This provision was added in consequence of the construction placed upon the Act of '93, in *Evans vs. Eaton, supra*, that a specification of *place* in the notice, was not necessary.

Curtis on Patents, Sec. 272.

It was passed as a remedial provision, to remedy a *defect* in the old law, and prevent the *surprises* liable to occur under it. It should therefore be construed as a remedial law, in such a manner as to suppress the mischief, and advance the remedy.

The Phil. & Trent. R. R. Co. vs. Stimpson, 14 Pet., 448.

Such a construction would find that the remedial provision requires the defendant to state in his notice the *place* "*where*" he claimed the invention to have been previously "*used,*" with such particularity as to fully and fairly apprise the plaintiff *where* he might inquire in order to ascertain the truth or falsehood of the notice. Is a notice, which names *six large cities* as the places, sufficiently particular for this purpose? or must it not specify *the mills*, also?

III.

The Act of '36 requires the notice to state "*where*" the invention had been previously "*used.*" The word "where," as employed in the

Act, signifies "*at or in which place or places;*" and hence the provision requires the notice to state at or in which places the invention had been previously "*used.*"

Now, on general principles of interpretation, can it be said in this sense, that a mill-stone balance is or can ever be "*used*" *in, and with relation to, a city?* It may be *located* in one; but the place or "*where*" of its *use*, must be *a mill.* A bridge, a sewer or a pavement might be "used" in and with relation to a city; they usually are so used; but not mill-stone balances. *Their* place and relation for *use*, are a *mill*, not a city. The words of the Act are—"*where used*," not where *located.*

IV.

It would hence appear to have been the intention of Congress in the Act of '36, that the notice should designate the place or "*where*" of alleged prior use, by some definite, limited locality, *appropriate to the use* of the thing in controversy; and in such a manner as to avoid the surprises constituting the mischief intended to be remedied; and not require the plaintiff to search through large cities in order to ascertain the facts of his case, and prepare to repel the falsehoods of the defence.

I. P. WALKER,

Plaintiff's Counsel.

Lucy Hamilton